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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MARTIN GUTFLEISCH
and MARTIN SCHMITT-LEWEN

Appeal 2008-2828
Application 09/923,696
Technology Center 2800

Decided:¹ February 11, 2009

Before EDWARD C. KIMLIN,² CHARLES F. WARREN, and
TERRY J. OWENS, *Administrative Patent Judges*.

OWENS, *Administrative Patent Judge*.

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 CFR § 1.304 begins to run from the decision date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

² APJ Kimlin has been substituted on the panel for APJ Waltz, the author of the Decision, who has retired.

DECISION ON REQUEST FOR REHEARING

The Appellants request reconsideration of the new rejections of claims 1-3, 5-12, 14-18, and 20-26 in our Decision mailed September 30, 2008 (Request 1).³ The Appellants argue that we erred in considering Koguchi's post treatment solution (col. 12, ll. 8-13) to clear image information, when it actually functions only to improve hydrophilicity (Request 2-3).

In our Decision we state that "Koguchi teaches supplementing the use of light with further treatment using an aqueous rinse solution, which corresponds to the claimed 'fluid clearing medium.' FF 2" (Decision 12), and that "Koguchi teaches a method of clearing all image information from a re-imageable printing form, comprising treating the printing form with a fluid clearing medium (water) in a non-abrasive manner, irreversibly clearing all image information on a surface of the printing form. *See* FF 2" (*See id.*) Factual Finding 2 (FF 2) is (Decision 4):

Koguchi teaches post-treating a printing plate after exposure to active light, the post-treatment comprising use of a rinse solution containing surfactant, aqueous solutions and the like. Col. 12, ll. 8-14. Such rinse solutions can be applied by wiping with a sponge or absorbent wadding, by dipping the plate, or by use of an automatic coater. Col. 12, ll. 14-19.

³ The Appellants do not request reconsideration of our affirmance of the rejections of claims 4 and 10 over Koguchi in view of Nüssel, and claim 13 over Koguchi in view of Nüssel and Shin (Decision 9-11).

Koguchi discloses:

After writing an image in heat mode on the surface of the plate material which has been exposed to active light, the plate material **3** can be used as a printing plate **3'** without development.

Though the non-imaged region of the resulting printing plate **3'** is sufficiently rendered hydrophilic, the printing plate **3'** may be subjected to, if desired, post treatment by use of a rinse solution containing surfactant, aqueous solution and the like and/or a grease insensitizing solution containing acacia gum and/or starch derivative. [col. 12, ll. 4-13]

....

Then the treated printing plate **3'** is discharged from the plate making device **1** and is wrapped around the plate cylinder **15** of the printer **2**. Thereafter ink and fountain solution are supplied from the ink/water supply section **16** and fountain solution and ink are respectively held by the non-imaged region and the imaged region. The ink image on the printing plate **3'** is transferred to the blanket **18** from the printing plate **3'** and then to a sheet of printing paper from the blanket **18**. [col. 12, ll. 24-32]

....

After the end of printing, the printing plate **3'** is cleared of ink at the ink washing section **17**. This is done by washing out ink adhering to the printing plate **3'** by use of hydrophobic petroleum solvent. [col. 12, ll. 44-47]

....

The printing plate **3'** which has been cleared off [sic] ink can be reused as a plate material **3** by another uniform exposure to active light unless it is exposed to a high temperature. [col. 12, ll. 51-53]

Thus, Koguchi teaches that the post treatment solution functions to render the non-imaged region of the printing plate more hydrophilic (col. 12, ll. 8-13), not to irreversibly clear all image information.

Hence, we grant the Appellants' Request and, accordingly, withdraw the new rejections in our Decision, i.e., the rejections of claims 1-3, 6, 9, 16-18, 21 and 26 under 35 U.S.C. § 102(b) over Koguchi, claims 7, 8, 10-12, 14, and 22-24 under 35 U.S.C. § over Koguchi, and claims 5, 15, 20 and 25 under 35 U.S.C. § 103 over Koguchi in view of Gydesen (Decision 12-15).

Under 37 C.F.R. § 41.50(b), we enter the following new grounds of rejection.

Claims 1, 4, 14-17, 19, and 26 are rejected under 35 U.S.C. § 102(b) over Nüssel (U.S. 5,317,970).

Claims 1, 4, 15, 16, 19, and 26: Nüssel discloses a method and apparatus for irreversibly clearing all image information from a surface of a re-imagable printing form in a single step by exposing the surface to the combustion product of hydrogen and oxygen, or to a plasma formed from a mixture of oxygen and carbon tetrafluoride, both of which are gaseous fluids (col. 2, ll. 29-39, 60-65; col. 3, ll. 18-32; col. 3, l. 59 – col. 4, l. 26). As indicated by Nüssel's disclosure that the prior art cleaning mechanically or abrasively stressed the printing form (col. 1, l. 66 – col. 2, l. 1), whereas Nüssel's cleaning takes place "without damage to the printing form or its surface, or attack of the surface" (col. 2, ll. 15-16), the cleaning is nonabrasive. Regarding claim 26, Nüssel's disclosure that the invention relates to a rotary printing machine (col. 1, ll. 15-16) indicates that the disclosed image clearing apparatus is part of a printing machine. As for claim 15, the clearing necessarily must take place either in the printing machine or in a device outside the printing machine.

Claim 14 recites: “The method according to claim 10, which includes providing oxygen as the gaseous medium.” Claim 10 recites: “The method according to claim 1, which includes providing acid as the fluid clearing medium.” Claim 1 recites: “A method for clearing a re-imageable printing form, which comprises treating the printing form with a fluid clearing medium in a non-abrasive manner, irreversibly clearing all image information on a surface of the printing form.” Because there is no clear antecedent basis for “the gaseous medium” in claim 14, it appears that claim 14 should depend from claim 1 instead of claim 10. For purposes of judicial economy we interpret claim 14 in that manner so as to permit a decision regarding the patentability of that claim over Nüssel. Nüssel discloses oxygen-containing gaseous clearing fluids (col. 4, ll. 4-5). Due to that disclosure and the disclosures pointed out above regarding claim 1, Nüssel discloses the invention claimed in claim 14.

Claim 17: Nüssel’s disclosure that the apparatus can irreversibly clear all image information from a surface without the use of substantial quantities of acids or solvents (col. 2, ll. 29-39, 44-46) indicates that the apparatus can clear all image information from a surface without first removing the ink therefrom and that, therefore, the apparatus necessarily is capable of clearing all image information from a surface after the surface has been washed free of ink.

Accordingly, claims 1, 4, 14-17, 19, and 26 are rejected under 35 U.S.C. § 102(b) over Nüssel.

This decision contains a new ground of rejection pursuant to 37 C.F.R. § 41.50(b). 37 C.F.R. § 41.50(b) also provides that Appellants,

WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

(1) *Reopen prosecution.* Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner. . . .

(2) *Request rehearing.* Request that the proceeding be reheard under § 41.52 by the Board upon the same record. . . .

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv) (2007).

GRANTED; 37 C.F.R. § 41.50(b)

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